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10 KEATING DENTAL ARTS, INC.

11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA
13 SOUTHERN DIVISION

14 JAMES R. GLIDEWELL DENTAL
15 CERAMICS, INC., DBA
16 GLIDEWELL LABORATORIES,
17 a California corporation,

18 Plaintiff,

19 vs.

20 KEATING DENTAL ARTS, INC.,
21 a California corporation,

22 Defendants.

23 KEATING DENTAL ARTS, INC.
24 a California corporation,

25 Plaintiff,

26 vs.

27 JAMES R. GLIDEWELL DENTAL
28 CERAMICS, INC., DBA
GLIDEWELL LABORATORIES,
a California corporation, and
DOES 1 THROUGH 5, inclusive,

Defendants.

Civil Action No.
SA-CV-11-01309-DOC(ANx)

**REPLY MEMORANDUM IN
SUPPORT OF MOTION FOR
PARTIAL SUMMARY
JUDGMENT OF NON-
INFRINGEMENT OF
TRADEMARK BRUXZIR®, AND
ON ALL THREE CAUSES OF
ACTION IN THE COMPLAINT**

**HEARING DATE:
Monday, March 26, 2012**

**HEARING TIME:
8:30 a.m.**

**REPLY MEMORANDUM IN SUPPORT OF MOTION FOR PARTIAL SUMMARY
JUDGMENT OF NON-INFRINGEMENT OF TRADEMARK BRUXZIR®**
Civ. Action No. SA-CV-11-01309-DOC(ANx)

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I. TABLE OF AUTHORITIES

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II. OVERVIEW

Perhaps intentionally, and as further explained below, Glidewell's (GW's) Opposition largely misses the point of the instant motion.

The motion is not challenging the validity of GW's mark BRUXZIR. It is not asserting that BRUXZIR is generic. It is not contending that GW's mark BRUXZIR is not extremely strong. It is not arguing that KDA's mark KDZ BRUXER is invalid or generic. It is not suggesting that two generic words cannot be combined to form a trademark. It is not debating whether GW has spent lots of money promoting its BRUXZIR product. It is not suggesting that GW has not sold lots of its BRUXZIR product.

Instead, the instant motion focuses on two words, each of which forms a part of the parties' marks, respectively: BRUX and BRUXER. KDA is asking the Court to hold that (for products related to bruxism that are sold to dental professionals) those two words BRUX and BRUXER are generic and not capable of being "owned" or controlled by any single party as a trademark.

Below, KDA attempts below to address at least most of the misdirected material in GW's Opposition. However, perhaps a simpler way to understand the present motion and the irrelevance of most of GW's Opposition is by considering a hypothetical fact pattern. In this hypothetical, rather than adopting BRUXZIR as the name of its product, GW adopted one of the words on which this motion focuses: BRUX or BRUXER. Thus, GW would have spent its millions of advertising and promotion dollars to develop that BRUX or BRUXER product name, and would have achieved millions of dollars and units of sales under that BRUX or BRUXER product name. If the Court then held (as KDA is requesting) that BRUX and BRUXER are generic terms with respect to these products

1 and markets, GW would have no trademark rights in BRUX or BRUXER
 2 (as noted in KDA's main brief, if a term lacks sufficient distinctiveness so
 3 that it is generic, the term "cannot be the subject of trademark protection
 4 under any circumstances." *Filipino Yellow Pages, Inc. v. Asian Journal*
 5 *Publ'ns*, 198 F.3d 1143, 1146 (9th Cir. 1999). Consequently, GW would
 6 not be able to stop KDA from using that generic term BRUXER in KDA's
 7 trademark for a competing product.

8 Given the actual facts, in which GW instead adopted and developed a
 9 different trademark (BRUXZIR) instead of BRUX or BRUXER, how can
 10 GW have the right to stop competitors from using BRUX or BRUXER
 11 (within or even AS the competitors' product names) that GW could not have
 12 gotten by adopting those words themselves?

13 The answer is that GW cannot have that right, and that the Court
 14 should so hold.

15 A. GW is NOT the First Company to Use BRUX in a Trademark for
 16 Dental Crowns

17 In perhaps its most relevant comment on the actual issue in the
 18 current motion, GW asserts that:

19 "Until PLAINTIFF adopted and began using its trademark
 20 BRUXZIR®, no one had used the term BRUX or BRUXER in
 21 a trademark for a dental restoration product. The various
 22 examples referred to in DEFENDANT'S Motion documents
 23 relate to products designed to inhibit or prevent nocturnal
 24 grinding of the teeth, not to crowns, bridges, etc." Opp. p. 14, l.
 25 25 through p. 15, l. 2.

26 GW's assertion is false. As shown in KDA's motion, BRUX was
 27 used in a trademark for dental crowns, beginning nearly three years
 28 BEFORE GW adopted its own BRUX-based trademark. Specifically, U.S.
 Trademark Reg. No. 3,775,126 was filed in May 2007, and alleges first use

1 in October 2006, on (among many other goods) dental crowns. KDA's
 2 Memo in Supp., p. 5, l. 24; Adnan Decl., p. 9-10. The mark covered by that
 3 registration is "DR. BRUX."

4 Indisputably, this shows that someone prior to GW "used the term
 5 BRUX or BRUXER in a trademark for a dental restoration product ... [such
 6 as] crowns." Among other things, this means that the only sliver of an
 7 argument that GW had made is based on a false statement. GW was not the
 8 first to use BRUX or BRUXER in a trademark for a dental crown. Most
 9 importantly for the present motion, it shows that GW has no basis for trying
 10 to preclude competitors from also doing so.

11 *B. KDA's Trademark is TWO Separate Words: KDZ BRUXER*

12 Preliminarily, and regardless of GW's motive for doing so, GW's
 13 Opposition is at least potentially misleading on one of the main facts in this
 14 lawsuit. KDA's trademark is KDZ BRUXER. It is two separate words,
 15 with five separate syllables. No matter how many times GW misstates it as
 16 a single word "KDZBRUXER" in its Opposition, KDA's trademark is not
 17 "KDZBRUXER."

18 For example, GW asserts that KDA's "mark consists of the plain
 19 letters KDZBRUXER as seen in an ad of Keating attached as an exhibit to
 20 the Complaint." GW Opp., p. 6, l. 26-27. Given the context of the present
 21 motion, it is important to note that GW's attempts to mislead on this point
 22 do not create a "genuine issue of material fact" and therefore are not
 23 sufficient to defeat KDA's requested summary judgment.

24 Instead, the undisputed evidence shows that there is not any "genuine
 25 issue of material fact" on this point. The Exhibit to which GW refers does
 26 not show the single word KDZBRUXER. Instead, as shown and set forth in
 27 the Brandon Declaration filed herewith, that exhibit shows "five separate
 28

1 uses of our trademark in plain text (highlighted by the red ovals), all of
 2 which show the mark as two separate words: “KDZ” and “BRUXER”. The
 3 one on the bottom left even separates those words onto two separate lines
 4 (par. 4).”

5 According to KDA’s General Manager Mr. Brandon, KDA has
 6 always used those as two separate words (KDZ BRUXER) (Brandon Decl.,
 7 par. 5), and it appears that only place in the world where they appear as a
 8 single word is in GW’s current Opposition (Brandon Decl., par. 6).

9 Moreover, all available evidence shows that GW is aware that it is
 10 misrepresenting this to the Court. At no time prior to its Opposition has
 11 GW asserted that KDA’s trademark is a single word KDZBRUXER. For
 12 example, through its entire Complaint and the exhibits attached thereto, GW
 13 always identifies the mark as two words:

- 14 • Ex. C to GW’s Complaint is a May 31, 2011 cease-and-desist
 15 letter to KDA’s counsel, from GW’s attorney Mr. Tachner. In
 16 that one page letter, in the space of its only two substantive
 17 paragraphs, Mr. Tachner correctly wrote KDA’s trademark as
 18 two separate words, and did so not less than THREE times.
- 19 • Ex. B to GW’s Complaint is a KDA advertisement that
 20 likewise shows KDA’s mark as KDZ BRUXER repeatedly
 21 (with a space, making it TWO words), and includes KDA’s
 22 stylized logo of the same trademark (see Brandon Decl.,
 23 above).
- 24 • In GW’s Complaint, GW’s attorney Mr. Tachner always
 25 identified the mark as KDZ BRUXER and never identified it as
 26 KDZBRUXER (without the space). He wrote it as two words
 27 at least 11 times within a 9-page Complaint. Nine of those
 28

1 were on the two main pages of “facts” (Complaint, p. 4 and 5).

2 GW itself has never previously described KDA’s trademark as a
 3 single word. For example, in his August 9, 2011 demand letter to KDA,
 4 GW’s Sales Manager (Robin Bartolo) wrote to KDA: “If you cancel your
 5 trademark application for **KDZ Bruxer** and use Bruxzir materials and the
 6 BruxZir trademark instead, we will not pursue legal action.” (emphasis
 7 added re the two **separate** words; Ex. L to Adnan Decl. filed with KDA’s
 8 Motion).

9 Despite the foregoing, GW’s opposition misrepresents KDA’s mark
 10 as KDZBRUXER (without the space) no less than eight times. Not once
 11 does GW state the mark correctly as two separate words (KDZ BRUXER,
 12 with the space). Apparently, GW is trying to confuse or mislead the Court
 13 into thinking that KDA’s trademark is more like GW’s single-word mark
 14 BruxZir. Rather than deal with the facts (the marks at issue are “BruxZir”
 15 and “KDZ Bruxer”), GW apparently wants the Court to think that the marks
 16 are “BRUXZIR” and “KDZBRUXER.” That is simply false, and is a
 17 potentially critical point for the Court’s consideration in this lawsuit: at
 18 bottom, in this trademark lawsuit, the Court must focus on the parties’
 19 trademarks – their actual trademarks.

20 C. BRUX and BRUXER Are Generic

21 Virtually nothing in GW’s opposition appears to even challenge
 22 whether BRUX and BRUXER are generic, let alone raise any genuine issues
 23 of material fact regarding same. Indeed, at several points, GW even seems
 24 expressly to admit that they are generic:

25 “BRUX is taken from the word BRUXISM which is a
 26 condition of nocturnal grinding of teeth known to cause
 27 extreme wear of posterior teeth. Use of the word portion
 28 BRUX is suggestive of hardness, durability and toughness that

1 is capable of resisting even such extreme wear.” GW Opp., p.
2 6, l. 6-9.

3 “...as used in PLAINTIFF’S trademark BRUXZIR®, the term
4 BRUX merely suggests that its restoration products are hard,
5 tough and durable.” GW Opp., p. 15, l. 4-6.

6 “BRUXER is a term used to describe a person who suffers from
7 the condition of Bruxism which is defined in the Background
8 section above.” GW Opp., p. 14, l. 7-8.

9 “PLAINTIFF has itself used [BRUXER] generically to refer to
10 one type of dental patient who might benefit from the fracture
11 resistance of the material.” GW Opp., p. 16, l. 20-21.

12 (Emphasis added).

13 Although GW makes two unsupported contrary assertions that BRUX
14 and BRUXER are not generic (see Opp. p. 14, l. 9-10., p. 16, l. 6-7), its only
15 attempt to provide evidence on that point consists of the false statement
16 noted above (that GW was the first to use the term BRUX or BRUXER in a
17 trademark for a dental restoration product).

18 Besides being deficient to defeat KDA’s instant motion, some related
19 parts of GW’s argument show the inherent inconsistency in even its
20 attempted (falsely supported) posture:

21 “As previously stated, as used in PLAINTIFF’S trademark
22 BRUXZIR®, the term BRUX merely suggests that its
23 restoration products are hard, tough and durable ***[and therefore***
24 ***suitable to treat nocturnal grinding of the teeth, or***
25 ***“BRUXISM”.]*** Opp. p. 15, l. 4-6. (emphasis added) [NOTE:
26 KDA insertions are shown in ***bold italics*** in the preceding
27 quote, and are discussed below.]

28 GW cannot have it both ways. On the one hand, GW wants to enjoy
the benefit of using “BRUX” in its own trademark BRUXZIR, to suggest to
dental customers that its BRUXZIR products are “hard, tough and durable”

– or as GW says in its actual marketing materials, that its BRUXZIR
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1 products are “for bruxers.” As noted elsewhere, this is exactly what other
 2 companies have been doing for decades prior to GW – using BRUX as part
 3 of their trademarks, to signal to dental customers that their products are
 4 “hard, tough and durable” – in other words, “for bruxers.”

5 On the other hand, GW wants to STOP its competitors from doing the
 6 same thing – using BRUX or BRUXER to signal to dental customers that
 7 their products are “hard, tough and durable” – in other words, that their
 8 products are “for bruxers.” On what legal principle does GW’s adoption of
 9 BRUXZIR give GW that right?

10 Separate from and independent of the aforementioned “Dr. Brux”
 11 trademark that predates GW’s use of BRUX in a trademark for dental
 12 crowns, GW falls short in its attempts to distinguish all of those earlier
 13 BRUX trademarks. All of those various products are designed to help
 14 dentists treat bruxism (nocturnal grinding of the teeth). Some of those
 15 products treat bruxism by trying to stop further “extreme wear.” Zirconia
 16 crowns and bridges treat bruxism by replacing teeth that have suffered
 17 “extreme wear” such as caused by bruxism. Thus, those trademarks all use
 18 BRUX to signal that the product is “for bruxers.”

19 *D. Other Generic Trademarks Shed Light on This Situation*

20 KDA could present to the Court a long list of decisions holding that
 21 certain words were generic (to counter the long list of contrary holdings that
 22 GW included in its Opposition), and will be glad to do so if the Court
 23 desires to review such a list. Instead, however, KDA directs the Court’s
 24 attention to a seminal case on this trademark genericity, *Kellogg Co. v.*
 25 *National Biscuit Co.*, 305 U.S. 111 (1938). *Kellogg* had a direct impact on
 26 the structure of the Lanham Act (the main U.S. Trademark Law), is a
 27 common starting point for analysis in trademark opinions in lower courts,

1 and has been called possibly "the Supreme Court's most versatile and
2 influential trademark decision". G. Dinwoodie, *The Story of Kellogg Co. v.*
3 *National Biscuit Co: Breakfast with Brandeis*, in Intellectual Property
4 Stories (R. Dreyfuss & J. Ginsburg eds., 2005).

5 In *Kellogg*, the Supreme Court ruled that the Kellogg was not
6 violating any trademark or unfair competition laws when it manufactured its
7 own Shredded Wheat breakfast cereal, which had originally been invented
8 by the National Biscuit Company (later called Nabisco). Kellogg's version
9 of the product was of an essentially identical shape, and was also marketed
10 as "Shredded Wheat"; but Nabisco's patents had expired, and its trademark
11 application for the term "Shredded Wheat" had been turned down as a
12 descriptive, non-trademarkable term. Among other things, the Court held
13 that:

14 The plaintiff has no exclusive right to the use of the term
15 'Shredded Wheat' as a trade name [a trademark]. For that is the
16 generic term of the article, which describes it with a fair degree
17 of accuracy; and is the term by which the biscuit in pillow-
18 shaped form is generally known by the public. Since the term is
19 generic, the original maker of the product acquired no
20 exclusive right to use it. As Kellogg Company had the right to
21 make the article, it had, also, the right to use the term by which
22 the public knows it. *Kellogg*, 305 U.S. 111, 116-7.

23 The Court dismissed a claim by Nabisco that is similar to some of
24 GW's assertions (that GW has spent millions of dollars advertising and has
25 made millions of dollars of sales under its BRUXZIR trademark) (GW Opp.,
26 p. 6, l. 19-21; p. 15, l. 8-23). In so doing, the Court noted Nabisco's
27 argument that Kellogg had waited many years to use the words "Shredded
28 Wheat," during which time Nabisco had been spending:

29 "...more than \$17,000,000 [in 1930's money] in making the
30 name [Shredded Wheat] a household word and identifying the

1 product with [Nabisco]. Those facts are without legal
 2 significance. Kellogg Company's right was not one dependent
 3 upon diligent exercise. Like every other member of the public,
 4 [Kellogg] was, and remained, free to make shredded wheat
 5 when it chose to do so; and to call the product by its generic
 6 name. The only obligation resting upon Kellogg Company was
 7 to identify its own product lest it be mistaken for that of the
 8 plaintiff.” *Kellogg*, 305 U.S. 111, 119 (emphasis added).

9 To help the Court more fully appreciate the facts relating to *Kellogg*,
 10 KDA has attached Ex. A hereto, showing examples of Nabisco’s early use
 11 of SHREDDED WHEAT as a trademark (presumably before the Supreme
 12 Court’s 1938 decision above), and also showing some of the many different
 13 trademarks that now include those generic terms “Shredded Wheat”.
 14 Similarly, the attached Ex. B shows many of the different trademarks that
 15 include the generic terms “Raisin Bran”.

16 Just as with the generic words SHREDDED WHEAT, competitors in
 17 the dental industry for decades have adopted the generic words BRUX or
 18 BRUXER within their own trademarks. In the current lawsuit, GW adopted
 19 BRUX within its mark BRUXZIR, and KDA adopted BRUXER within its
 20 mark KDZ BRUXER. As the Supreme Court stated in *Kellogg*, the amount
 21 of GW’s advertising and sales are irrelevant to the legal question of whether
 22 BRUX and BRUXER are generic.

23 Moreover, as noted in KDA’s main brief, even if GW’s BruXZir mark
 24 had acquired secondary meaning, that does not mean that the BRUX and
 25 BRUXER terms (to which GW wants ownership) have developed any such
 26 “secondary meaning”.

27 *E. GW’s Other Arguments are Red Herrings, Unsupported, and/or*
 28 *Irrelevant*

GW’s opposition makes numerous “factual” assertions that have no
 supporting evidence. For example, GW asserts that:

- GW's product is "the gold standard by which other dental restoration products are judged".
- GW's BruxZir products have "become over the past two and half years" GW's most successful restoration product in the company's 42-year history.

Although irrelevant, GW tries to argue that KDA "admits" that BRUXER is not generic because KDA included BRUXER as part of its pending trademark application. In its application, KDA affirmatively "disclaimed" the exclusive right to use the word BRUXER. This is a commonplace trademark practice, and is called a "disclaimer." (the public record is available on the U.S. Patent and Trademark Office website at <http://tess2.uspto.gov/bin/showfield?f=doc&state=4006:agaddh.2.3>, with the disclaimer language five lines up from the bottom of the page).

III. CONCLUSION

Competitors in the dental industry have long used the generic/descriptive terms BRUX and/or BRUXER in their trademarks on products "for bruxers." GW did likewise (generic "BRUX" in its BRUXZIR mark), and KDA should have the same right to do so (generic "BRUXER" within its KDZ BRUXER mark). This permits all of the competitors in this industry to draw a desirable and lawful connection between their products and the intended users and uses of those products: "bruxers."

Dated: 2012-03-12

/J. Mark Holland/

J. Mark Holland

J. MARK HOLLAND & ASSOCIATES

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